

an icicle) having a plurality of lights fixed to the fixture with vertical mounting being a necessity for the fixtures to appear to be icicles.

Decorative Lights
First, the perusal of the title will show this to be nonanalogous art since applicant is not creating lighted icicles.

Here the Examiner is directed to the decision in The Anderson Company et al. v. Trico Products Corporation, (DC WNY) 118 USPQ 49 1958:

"...it is noted that patent is limited on its face by its title; hence, claims must be construed with some strictness."

Secondly, the major portion of the disclosure relates to the structure of icicle shaped casing, with the lights being mentioned only as an aside. The Examiner cannot dissect the teaching of Adler into bits and pieces and still bottom his anticipation rejection on a solid evidentiary base. Here see Panduit Corp., v. Dennison Manufacturing Co., 1 USPQ2d 1593 (Fed. Cir. 1987):

(1) "A prior patent must be considered in its entirety (i.e., as a whole), including portions that would lead away from the invention in issue."

Thirdly, Adler's disclosure states the lights are connected in series OR parallel. Applicant on the other hand discloses that the LIGHTS are to be connected in series and that the STRINGS are connected to the power cord in parallel.

Picking and choosing from various options disclosed is not anticipatory under the law. Here, see Mendenhall v. Astec

Industries, Inc., 13 USPQ2d 1913, 1939 (TN 1988), aff'd, 13 USPQ2d 1956 (Fed. Cir. 1989):

(2) "When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate."

Based on the above, the anticipation rejection is not upheld and must be withdrawn.

The Examiner next states:

"Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adler as applied to claim 1 above, and further view of Lehmann et al."

The ambiguous opinion is not understood by applicant, with respect to the rejection of claim 5.

Applicant needs enlightening details to be able to respond appropriately.

The Examiner continues:

"Lehmann teaches of a power supply cord include including a circuit protection device (col. 1, lines 15-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a circuit protection device so as not to ignite the light string."

Lehmann at Col. 1, lines 15-45 defines prior art 18-20 gauge wire, with unfused string sets of smaller gauge wire not being protectable by circuit breakers or fuses.

He suggests combining fused string sets of smaller wire to

overcome the nonfunctionality of circuit breakers and fuses.

Applicant does not have fused string sets and finds Lehmann not only without pertinence, but leading away from applicant's teaching.

Here see Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986) USPQ 657 (Fed. Cir. 1985):

"It is impermissible within the framework of 35 USC 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art."

The Examiner is taking bits and pieces and presenting illogical and unmotivated combinations thereof, which the Examiner modifies, also illogically, to fit applicant's "mold" in order to deprecate his claims.

Referring to the decision in In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) "

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

All rejections must be withdrawn, and the application must pass to allowance based on the arguments presented above.

Respectfully submitted,

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